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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/171,607 11/04/98 FORSSMANN

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HM22/0314

EXAMINER

DECLoux, A

ART UNIT

PAPER NUMBER

1644

10

DATE MAILED:

03/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/171,607

Applicant(s)
Forssmann et al.

Examiner
DeCloux, Amy

Group Art Unit
1644



☒ Responsive to communication(s) filed on Jan 20, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 9 is/are allowed.

☒ Claim(s) 1-8 and 10-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The claim to priority to PCT/EP97/02012, filed 4/22/97, disclosed in the Oath/Declaration, needs to be included as the first sentence of the specification following the title, preferably as a separate paragraph.
2. The claim to foreign priority in document FRG 19615710, filed 4/22/96, disclosed in the Oath/Declaration, is not granted since MPEP 201.13 C requires that there be the same inventive entity in the U.S. and the foreign priority country. Ludger Staendker is not named as an inventor on said foreign priority document.
3. The CRF submitted by the applicant (1/20/00) has been corrected by the STIC Systems Branch as follows: 1) changed a file from non-ASCII to ASCII, 2) changed the margins in cases where the sequence text was "wrapped" down to the next line, 3) added the mandatory headings and subheadings for "Current Application Data", 4) deleted non-ASCII "garbage" at the end of files.
4. Claim 1 is objected to because of the following informality:
Claim 1 recites an amino acid sequences that is not identified by its corresponding SEQ ID NO. The applicants are required to recite the appropriate SEQ ID NO in the claims. Also, a sequence is disclosed in the specification on page 3 which is not identified by a corresponding SEQ ID NO. Applicant is required to insert "SEQ ID NO:1" after both of these sequences.
5. The reference DE 3633797 A1, cited in the in the PTO Form 1449 and initialed by the Examiner, was not considered, since an English translation was not provided. If applicants wish to have said reference considered, a translation in English should be supplied to the office.
6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: antecedent basis is lacking for the phrase "pharmacologically active" recited in claims 3-6, 8, 10-14 and 16-21, for the phrase "electrolytic activity" recited in claim 17, and pharmacologically compatible" recited in claim 1 and dependent claims 2-21. It is suggested that the Applicants amend the specification to include this limitation, in order to overcome this rejection.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabled for a method of treatment by the administration of an antibody against HF-COLL-18/514cf as an antagonist/inhibitor, does not reasonably provide enablement for a method of treatment by the administration of any "antagonist/inhibitor of HF-COLL-18/514cf" as recited in Claim 10. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Factors to be considered in determining whether undue experimentation is required are summarized in *In re Wands* (858 F2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)). The factors most relevant to this rejection are the scope of the claim, unpredictability in the art, the amount of experimentation required, and the amount of direction or guidance presented.

Claim 10 is drawn to a method for the treatment of patients by the administration of an antagonist/inhibitor of HF-COLL-18/54cf. However, the specification does not enable one of skill in the art regarding how to make any antagonist/inhibitor of HF-COLL-18/54cf as recited in the instant claims, except for an antibody against HF-COLL-18/514cf, nor how to use any antagonist/inhibitor of HF-COLL-18/54cf in a method for the treatment of patients as recited in the instant claim, with the exception of an antibody against HF-COLL-18/514cf. There is insufficient guidance and direction provided in the specification on how to identify and therefore make any antagonist/inhibitor of HF-COLL-18/54cf as recited in the instant claims, except for an antibody against HF-COLL-18/514cf. Also, there is insufficient guidance and direction provided in the specification that any antagonist/inhibitor of HF-COLL-18/54cf is efficacious in a method for the treatment of patients as recited in Claim 10. Therefore, it is not clear that the skilled artisan could predict the efficacy of any antagonist/inhibitor of HF-COLL-18/54cf, with the exception of an antibody against HF-COLL-18/514cf, in a method for the treatment of patients as recited in the instant claim. Based upon the paucity of information contained within the instant

specification in this regard, it would require an undue amount of experimentation on the part of one skilled in the art to make and/or use any antagonist/inhibitor of HF-COLL-18/54cf for the method of treatment of patients, as recited in Claim 10.

In view of the quantity of experimentation necessary to use the claimed invention, the lack of working examples, the unpredictability of the art, the lack of sufficient guidance in the specification, it would take undue trials and errors to practice the claimed invention and this is not sanctioned by the statute.

9. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11-19 provide for the use of medicaments where the instant claims recite a method of treatment of diseases of the human organism, but since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 11-19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

12. Claims 1-8, 10-14 and 16-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

A) Claims 2-8, 10-14 and 16-21 lack an antecedent basis in the recitation of "pharmacologically active" and "pharmacologically compatible".

B) Claim 2-8, 10-14 and 16-21 are indefinite in the recitation of "pharmacologically active" and "pharmacologically compatible" because it is not clear exactly how the phrases are defined.

C) Claims 3-4 are indefinite in their recitation of a process for the preparation of the peptide because the process does not clearly set forth method steps and there is an absence of a resolution step.

D) Claim 3 is indefinite in its recitation of "characterized in that" because it is not clear how said phrase modifies said process. Please clarify.

E) Claim 17 is indefinite in its recitation of "electrolytic activity" because it is not clear what said phrase means. Please clarify.

F) Claim 17 lacks an antecedent basis in the recitation of "electrolytic activity".

G) Claim 17 is indefinite in its recitation of "treatment of systemic diseases in an overproduction or deficiency of HF-COLL-18/514cf" (underline added) because it is not clear what "in an " means, possibly it means "with". Please clarify.

H) Claims 20-21 are indefinite in their recitation of a diagnostic agent because it is not clear what the agent is capable of diagnosing and accordingly, there is an absence of a resolution step.

I) Claims 1, 11-14 and 16 are indefinite in its recitation of "especially" because said term is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining what is special, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

J) Claim 15 is indefinite for being in improper Markush format. The Office recommends setting off the last member by an --or--, not "and".

13. SEQ ID NO:1 which encodes the peptide HF-COLL-18/514cf appears to be free of prior art, as does claim 9 which encompasses a method of treatment involving the administration of HF-COLL-18/514cf.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Amy DeCloux, Ph.D.
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March 13, 2000

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT 182/644